

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT: Masaaki Yamanaka et al. **EXAMINER:** Kruer, Kevin R.

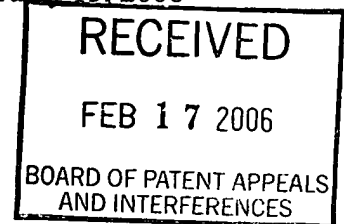
APPEAL NO.: 2005-2639

SERIAL NO.: 08/855,905 **GROUP ART UNIT:** 1773

FILED: May 14, 1997 **DATED:** February 15, 2006

FOR: SYNTHETIC PAPER MADE OF
STRETCHED POLYPROPYLENE FILM

Mail Stop: Board of Patent Appeals and Interferences
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450



TRANSMITTAL OF APPELLANTS' REQUEST FOR REHEARING

Sir:

Enclosed please find an APPELLANTS' REQUEST FOR REHEARING.

It is believed that this response does not occasion any fees, but should there be any fee please charge to Deposit Account No. 04-1121. THREE COPIES OF THIS SHEET ARE ENCLOSED.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Leo G. Lenna". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Leo G. Lenna
Reg. No.: 42,796
Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
516-228-8484

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Request for Hearing in triplicate is being deposited with the United States Postal Service as first class mail, postpaid in an envelope addressed to the: Mail Stop: Board of Patent Appeals and Interferences, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 15, 2006.

Dated: February 15, 2006

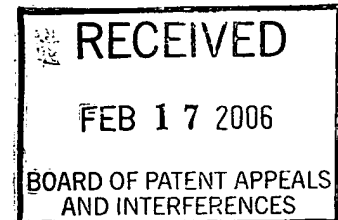
A handwritten signature in black ink, appearing to read "Leo G. Lenna". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Leo G. Lenna

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT: Masaaki Yamanaka et al. **EXAMINER:** Kruer, Kevin R.
APPEAL NO.: 2005-2639
SERIAL NO.: 08/855,905 **GROUP ART UNIT:** 1773
FILED: May 14, 1997 **DATED:** February 15, 2006
FOR: SYNTHETIC PAPER MADE OF
STRETCHED POLYPROPYLENE FILM

Mail Stop: Board of Patent Appeals and Interferences
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450



APPELLANTS' REQUEST FOR REHEARING

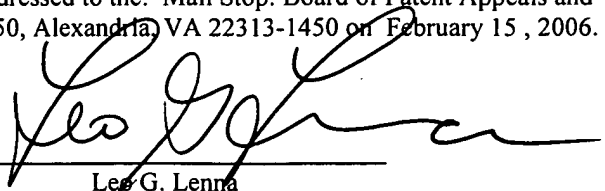
Sir:

Pursuant to 37 C.F.R. §41.52, please enter and consider the following Request for Rehearing in response to the Decision of Appeal mailed December 16, 2005. 37 C.F.R. §41.52 sets a statutory period of two months from the date of the original decision to file a Request for Rehearing. Accordingly, this Request is filed timely upon mailing with an executed Certificate of Mailing on or before February 16, 2006.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Request for Hearing in triplicate is being deposited with the United States Postal Service as first class mail, postpaid in an envelope addressed to the: Mail Stop: Board of Patent Appeals and Interferences, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 15, 2006.

Dated: February 15, 2006


Lee G. Lenna

I.. The Decision on Appeal Failed to Consider A Three-Layered Synthetic Paper.

In the first full paragraph on page 15 of the Examiner's Answer, it is stated:

The inventive paper shows improvement with regard to antistatic properties and printability. However, the examiner found the results non-persuasive for a number of reasons. Specifically, the experiment does not agree in scope with the present claims because the claims do not require a 3-layered film. [Emphasis added].

However, Claim 47 of the present application is specifically directed to a three layer

synthetic paper. Claim 47 is reproduced directly below:

A synthetic paper which comprises a biaxially stretched thermoplastic resin film base material and, laminated on each side, a surface layer consisting of a uniaxially stretched film of the resin composition as claimed in Claim 28.

As can be seen from claim 47 above, the synthetic paper clearly comprises a thermoplastic resin film, and a surface layer laminated on each side to produce a three-layer synthetic paper. Although this point was raised as an incorrect statement by the Examiner in Section II of the Appellants' Reply Brief, mailed May 25, 2005, the Decision on Appeal did not address this incorrect statement.

In view of the foregoing, it is believed that the second supplemental declaration executed July 12, 2002 by Masaaki Yamanaka (The Yamanaka III Declaration), which demonstrates synthetic paper having the improved antistatic properties and printability as acknowledged in the Examiner's Answer (reproduced above), cannot be dismissed since the experiments performed in this Declaration agree with the scope of the invention, namely the three-layered film of Claim 47. Therefore, it is respectfully requested that this Request for Rehearing be granted so that The Board of Appeals can fully address this issue.

II. The Yamanaka III Declaration has been misinterpreted by the Board.

In the first full paragraph of page 20 of the Decision on Appeal, it is stated that the Yamanaka III Declaration (Second Supplemental Declaration dated July 12, 2002) contains significant basic differences between Takashi et al. and Experiments 1-3 set forth therein. In particular, it is stated:

The base layer of Takashi [et al.] Example 12 contains an antistatic agent which was omitted in declaration III Experiments 1-3, and the antistatic agent of the paper-like layer of Experiment I has been changed to a different type than used in Takashi [et al.] Example 12...[Emphasis added].

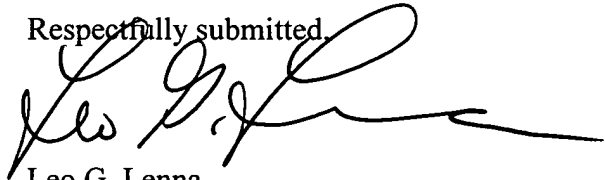
However, a review of table I (b) at columns 9-10 of Takashi et al.(U.S. Pat. No. 4,318,950), which describes the base layer components of Experiment 12, does not, in fact, include an anti-static agent. Therefore, Experiments 1-3 of Declaration III, which also does not use an anti-static agent in making the base-layer of the paper, does not differ from Experiment 12 in this regard (as stated in the Decision on Appeal) but, is in fact is consistent with Experiment 12. Therefore, it is respectfully requested that this Request for Rehearing be granted so that The Board of Appeals may reconsider this issue and Yamanaka III Declaration for what it properly documents.

Further, the Yamanaka III Declaration clearly states the reason low molecular weight anti-static RESISTAT PE 132 of Takashi et al. was not used in the numerated experiments was because it was no longer available. Instead, the low molecular weight antistatic agent PHOSPHANOL RL-20 (formerly Phospanol SM-1 and used in other examples of Takashi et al.) was used in Experiment 1 as a substitute for the discontinued anti-static agent. The alternative would have been to use a totally different anti-static agent not even described by

Takashi et al. This issue is not only limited to the Yamanaka III Declaration but applies to the other Declarations as well. Therefore, it is respectfully asserted the Declarations submitted in support of patentability, the Yamanaka III Declaration in particular, are not faulty in this respect, but represent the paper produced in Experiment 12 of Takashi et al. as closely as can be done under the circumstances. To conclude anything else would effectively prevent the Appellants from providing any comparative data to demonstrate patentability of the claimed invention. For this additional reason, the Appellants respectfully request that this Request for Rehearing be granted so that The Board of Patent Appeals and Interferences may address this issue.

In view of the foregoing, the Appellants respectfully request that the Request for Rehearing be granted, the issues stated above be reconsidered, and all claims allowed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Leo G. Lenna', written over the typed name.

Leo G. Lenna

Reg. No.: 42,796

Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
516-228-8484